

REMARKS

Entry of the foregoing and reconsideration of the application identified in caption, as amended, pursuant to and consistent with 37 C.F.R. §1.111 and in light of the remarks which follow, are respectfully requested.

By the above amendments, claims 5 and 7 have been canceled without prejudice or disclaimer. Claims 1-4 and 6 have been amended for readability and/or clarification purposes. New dependent claim 15 depends from claim 1, and recites that the low-refractive-index layer has a coefficient of kinetic friction of 0.15 or less. New claim 16 is directed to the subject matter of claims 2 and 3.

In the Official Action, claims 6 and 7 stand objected to for the reasons set forth at pages 2 and 3 thereof. In accordance with the Examiner's suggestion, claim 6 has been amended to depend from claim 1. The objection of claim 7 is moot in light of the cancellation of such claim. Accordingly, withdrawal of the objection is respectfully requested.

Claims 1-10, 12 and 14 stand rejected under 35 U.S.C. §103(a) as being obvious over U.S. Patent No. 5,909,314 (*Oka et al*). Withdrawal of this rejection is respectfully requested for at least the following reasons.

Independent claim 1 recites a film having a high transmittance and matt property, comprising, on a transparent support, (a) a hard coat layer comprising particles incorporated therein, wherein the particles have a particle size of from 1.0 to 10 μm that is larger than the thickness of the hard coat layer thereby providing a concavo-convex structure, and wherein a density of the particles is in a range of from 100 to 5000 particles/ m^2 , and (b) a low-refractive-index layer having a refractive index of 1.45 or less, wherein the low-refractive-index layer covers said hard coat layer so as to maintain said concavo-convex structure

formed by said particles incorporated in the hard coat layer, wherein the film shows a haze value of 1.0 % or more, and a total transmittance of light of 93.5 % or more.

Oka et al does not disclose or suggest each feature recited in independent claim 1. For example, *Oka et al* does not disclose or suggest a film having a high transmittance and matt property, comprising a hard coat layer comprising particles incorporated therein, wherein a density of the particles is in the range of 100 to 5,000 particles/m². In this regard, *Oka et al* provides no explicit disclosure of the density of the particles being in the range of from 100 to 5,000 particles/m². Moreover, the Patent Office has not established with the requisite certainty, that *Oka et al* inherently discloses particles having a density in the claimed range.

The Patent Office's burden of proof for properly alleging an inherent disclosure is well established. "To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.'" *In re Robertson*, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (emphasis added). "In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent feature necessarily flows from the teachings of the applied prior art." *Ex Parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original).

In the present case, the Patent Office has asserted that *Oka et al*'s disclosure of total transmittance of light and haze characteristics, constitutes an inherent disclosure of the claimed density of the particles in the range of from 100 to 5,000 particles/m² (Official

Action at page 4). However, the Patent Office has not provided any evidence or scientific reasoning which establishes that the density of the particles can be determined with certainty in view of transmittance of light and haze characteristics. And certainly, the Patent Office has not shown how the specifically claimed particle density range is necessarily present as a result of *Oka et al*'s transmittance of light and haze characteristics.

In light of the above, it is apparent that the Patent Office has failed to meet its burden of proof for establishing inherency of this claimed feature.

Furthermore, *Oka et al* fails to disclose or suggest a hard coat layer comprising particles incorporated therein, wherein the particles have a particle size of from 1.0 to 10 μm that is larger than the thickness of the hard coat layer thereby providing a concavo-convex structure, as recited in claim 1. In the film disclosed in FIG. 17 of *Oka et al* which has been relied on by the Patent Office, the matte material (18) having a particle size that is substantially smaller than the thickness of the antiglare layer (17), is positioned to protrude from the top of the antiglare layer to form a matted surface. Thus, at best, *Oka et al* recognizes that a matte surface can be formed by adjusting the position of the matte material in the antiglare layer. *Oka et al* simply has no recognition or suggestion that employing a particle size that is larger than the thickness of a hard coat layer, can be effective to provide a concavo-convex structure. Absent an improper resort to Applicants' own disclosure, one of ordinary skill in the art would not have been motivated to employ the claimed relationship between the particle size of the particles and the thickness of the hard coat layer, to thereby provide a concavo-convex structure.

For at least the above reasons, it is apparent that no *prima facie* case of obviousness exists. Accordingly, withdrawal of the above §103(a) rejection is respectfully requested.

From the foregoing, further and favorable action in the form of a Notice of Allowance is believed to be next in order, and such action is earnestly solicited. If there are any questions concerning this paper or the application in general, the Examiner is invited to telephone the undersigned.

Respectfully submitted,

BURNS, DOANE, SWECKER & MATHIS, L.L.P.

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By: _____

Roger H. Lee

Registration No. 46,317

P.O. Box 1404
Alexandria, Virginia 22313-1404
(703) 836-6620